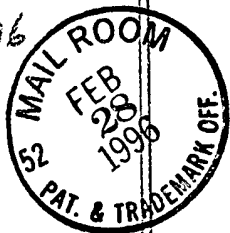


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PATENT

Attorney Docket No. 3495.0010-19

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Marc ALIZON et al.

Serial No.: 08/308,218

Filed: September 19, 1994

For: DNA SEQUENCES AND PEPTIDES OF HUMAN IMMUNODEFICIENCY
VIRUS (HIV-1)

Group Art Unit: 1805

Examiner: J. RAILEY II

Assistant Commissioner for Patents
Washington, D.C. 20231

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Sir:

GROUP 1800

REQUEST FOR WITHDRAWAL OF SUSPENSION OF ACTION

Applicants respectfully request withdrawal of the
Suspension of Action.

Applicants acknowledge receipt of the communication of
November 22, 1995, which states that the outcome of Interference
No. 102,822 is material to the patentability of the above-
identified application. The Examiner concludes that prosecution
of this application should be suspended.

MPEP 2315.01 provides insight as to the suspension of
overlapping applications:

Where one of several applications of the
same inventor or assignee which contain
overlapping claims gets into an
interference, the **prosecution of all the**
cases not in the interference should be
carried as far as possible, by treating
as prior art the counts of the
interference and by insisting on **proper**

lines of division or distinction between
the applications. [Emphasis supplied.]

In this case, the prosecution has been carried out as far as possible as confirmed in a telephonic conference with Examiner Railey on January 24, 1996. Applicants urge that the claim of the above-identified application and the claims of the interference are distinct, drawing a "proper line of division" between the instant invention and the interference count, and do not overlap.

The claim of the instant application is directed to the *nef* gene of HIV-1. The nucleic acid sequence of the *nef* gene corresponds to nucleotides 8249-8906 of the HIV-1 genome. Interference No. 102,822, on the other hand, involves HIV-1 genes other than the *nef* gene. Applicants respectfully submit that the instant invention is separate and distinct from the claims in the interference.

MPEP 2315.01 provides that an "overlapping" application involved in an interference by the same inventor or assignee that is a separate and divisible invention from the interfering application "may not be passed to issue if it contains claims broad enough to dominate matter claimed in the application involved in the interference." [Emphasis supplied.] See also MPEP 1111.03. This doctrine of "domination" occurs when a broad claim of the first patent application reads on a narrow claim of a second patent application. In re Kaplan, 789 F.2d 1574, 1577,

229 U.S.P.Q. 678, 681 (Fed. Cir. 1986). The doctrine of domination refers

. . . to that phenomenon, which grows out of the fact that patents have claims, whereunder one patent has a broad or 'generic' claim which 'reads on' an invention defined by a narrower or more specific claim in another patent, the former 'dominating' the latter because the more narrowly claimed invention cannot be practised [sic, practiced] without infringing the broader claim. . . In possibly simpler terms, one patent dominates another if a claim of the first patent reads on a device built or process produced according to the second patent disclosure.

Id. Thus, in order to assess domination, one must determine whether or not the broad claims "embrace" or "encompass" the subject matter defined by the narrower claim. Id.

The instant application is derived from the application involved in the interference. As noted above, however, the instant invention is separate and distinct from the subject matter of the interference. The subject matter of the instant case, i.e., the *nef* gene, cannot be construed broadly to dominate the other HIV-1 genes involved in the interference proceeding. The *nef* gene does not "embrace" or "encompass" the other HIV-1 genes. Thus, there is no case of "domination" since the instant claim does not broadly read on the claims of the interference.

Applicants' claim is patentably distinct from the subject matter of the interference, and since the *nef* gene does not dominate the other HIV-1 genes, Applicants respectfully request reconsideration and the withdrawal of the suspension of action.

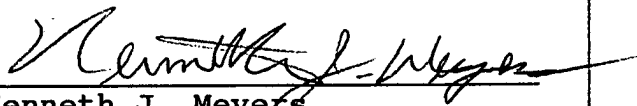
Applicants also respectfully request prompt allowance of the instant application.

If there are any other fees due in connection with the filing of this response, including any fees required for an extension of time under 37 C.F.R. § 1.136, such an extension is requested, and the Commissioner is authorized to charge any related fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By:


Kenneth J. Meyers
Reg. No. 25,146

Dated: February 28, 1996

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